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Reply Brief Under 37 C.F.R. §41.41 (32 sheets)

Application Number	09/650,733	Art Unit: 3628
Confirmation No.:	2432	Examiner: Vincent, David Robert
Filing Date:	30 August 2000	Inventor: Pilato, Alejandro M.
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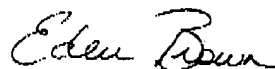
Docket: **1011-002**   **Pages: 33**

25 Jul 2005	Eden Brown	_(signature)_
Date	Name of Certifier	Signature of Certifier

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Alejandro M. Pilato
Application #	:	09/650,733
Confirmation #	:	2432
Filed	:	30 August 2000
Application Title	:	METHOD AND SYSTEM FOR PROVIDING FINANCIAL FUNCTIONS
Art Unit #	:	3628
Latest Examiner	:	David Robert Vincent

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Commissioner for Patents

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REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

The Applicant respectfully submits this Reply Brief in response to the Office Action of 25 May 2005 finally rejecting each of the pending claims 1-139. This Reply Brief is in furtherance of the Notice of Appeal filed 1 September 2004. Applicants respectfully request that the appeal be maintained as provided in 37 C.F.R. §41.39(b)(2).

I.   REAL PARTY IN INTEREST

The real party in interest is Traderisks, Inc., a corporation having a place of business at 9 East Loockerman Street, Dover, Delaware 19901.

II.   RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III.   STATUS OF CLAIMS

Claims 1-139 are pending in this application and have been finally rejected. Claims 1-139 are the subject of this appeal.

IV.   STATUS OF AMENDMENTS

A reply to the final rejection was filed on 7 July 2004. That reply sought to amend claim 112. In the Advisory Action dated 24 August 2004, entry of the amendment of claim 112 was denied without explanation.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1

Claim 1 recites a computer-assisted method (see at least page 25, lines 1-25; FIGs. 1, 2, 3) for providing financial functions by an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) for each of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13). The method comprises a plurality of activities (see at least FIG. 1), including, relating to a financial function of each client (see at least page 1, lines 5-7):

demonstrating that more than one activity of the agent is transparent to the client

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(see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28);

  receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

  creating risk management information relating to the financial information (see at least FIG. 1, element 1040; page 19, line 29);

  analyzing the risk management information in the context of the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5);

  determining an action based on the analysis (see at least FIG. 1, element 1060; page 22, lines 27-28);

  facilitating implementation of the action on behalf of the client (see at least FIG. 1, element 1070; page 23, lines 19-20); and

  communicating with the client (see at least FIG. 2, element 2100) through a network (see at least FIG. 2, element 2900) one or more activities of the agent (see at least FIG. 1, elements 1025, 1045, 1055, 1065, and 1075; page 25, lines 5-6).

Dependent claim 15

To independent claim 1, claim 15 adds the limitation that the activity of communicating includes allowing the client to monitor across a network one or more activities of the agent (see at least page 11, lines 4-20; page 18, lines 1-2; page 25, lines 5-13).

Dependent claim 16

To independent claim 1, claim 16 adds the limitation that the activity of communicating includes allowing the client to monitor in real-time across a network one or more activities of the agent (see at least page 7, lines 11-19; page 11, lines 4-20; page 18, lines 1-2; page 25, lines 5-13).

Dependent claim 17

To independent claim 1, claim 17 adds the limitation that the activity of communicating includes allowing the client to monitor in near-real-time across a network one or more activities of the agent (see at least page 7, lines 11-19; page 11, lines 4-20; page 18, lines 1-2; page 25, lines 5-13).

Dependent claim 52

To independent claim 1, claim 52 adds the limitation that the financial function includes repo funding (see at least page 32, lines 24-25).

Dependent claim 53

To independent claim 1, claim 53 adds the limitation that the financial function includes debt management (see at least page 2, lines 18-20).

Dependent claim 54

To independent claim 1, claim 54 adds the limitation that the financial function includes debt issuance (see at least page 32, lines 20-22).

Dependent claim 55

To independent claim 1, claim 55 adds the limitation that the financial function includes asset and liability management (see at least page 2, lines 18-20).

Dependent claim 56

To independent claim 1, claim 56 adds the limitation that the financial function includes asset and liability management and wherein the assets include insurance premia (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 57

To independent claim 1, claim 57 adds the limitation that the financial function includes asset and liability management and wherein the liabilities include insurance claims (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 58

To independent claim 1, claim 58 adds the limitation that the financial function includes asset and liability management and wherein the assets include life insurance premia (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 59

To independent claim 1, claim 59 adds the limitation that the financial function includes asset and liability management and wherein the liabilities include life insurance claims (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 60

To independent claim 1, claim 60 adds the limitation that the financial function includes asset and liability management and wherein the liabilities include pension claims (see at least page 5, lines 14-28; and page 35, lines 14-19).

Dependent claim 61

To independent claim 1, claim 61 adds the limitation that the financial function includes asset and liability management and wherein the liabilities include legal claims (see at least page 5, lines 14-28; and page 40, lines 11-19).

Dependent claim 62

To independent claim 1, claim 62 adds the limitation that the financial function includes asset and liability management wherein the assets include leases (see at least page 5, lines 14-28).

Dependent claim 63

To independent claim 1, claim 63 adds the limitation that the financial function includes asset and liability management wherein the liabilities include leases (see at least page 5, lines 14-28).

Dependent claim 64

To independent claim 1, claim 64 adds the limitation that the financial function includes asset and liability management wherein the assets include operational cashflows (see at least page 5, lines 14-28).

Dependent claim 65

To independent claim 1, claim 65 adds the limitation that the financial function includes asset and liability management wherein the liabilities include operational cashflows (see at least page 5, lines 14-28).

Dependent claim 66

To independent claim 1, claim 66 adds the limitation that the financial function includes treasury management (see at least page 2, lines 16-30).

Dependent claim 67

To independent claim 1, claim 67 adds the limitation that the financial function includes credit management (see at least page 2, lines 16-30).

Dependent claim 68

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To independent claim 1, claim 68 adds the limitation that the financial function includes credit spread trading (see at least page 2, lines 16-30).

Dependent claim 69

To independent claim 1, claim 69 adds the limitation that the financial function includes loan portfolio management (see at least page 2, lines 16-30).

Dependent claim 70

To independent claim 1, claim 70 adds the limitation that the financial function includes equity portfolio management (see at least page 5, lines 14-28).

Dependent claim 71

To independent claim 1, claim 71 adds the limitation that the financial function includes fixed income portfolio management (see at least page 35, lines 14-19).

Dependent claim 72

To independent claim 1, claim 72 adds the limitation that the financial function includes funding (see at least page 2, lines 16-30).

Dependent claim 73

To independent claim 1, claim 73 adds the limitation that the financial function includes collateral management (see at least page 2, lines 16-30).

Dependent claim 74

To independent claim 1, claim 74 adds the limitation that the financial function includes the lending of securities (see at least page 3, lines 22-24).

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Dependent claim 75

To independent claim 1, claim 75 adds the limitation that the financial function includes the borrowing of securities (see at least page 3, lines 22-24).

Dependent claim 76

To independent claim 1, claim 77 adds the limitation that the financial function includes counterparty credit exposure management (see at least page 5, lines 14-28).

Dependent claim 78

To independent claim 1, claim 78 adds the limitation that the financial function includes market risk management (see at least page 2, lines 16-30).

Dependent claim 79

To independent claim 1, claim 79 adds the limitation that the financial function includes credit risk management (see at least page 2, lines 16-30).

Dependent claim 80

To independent claim 1, claim 80 adds the limitation that the financial function includes commodity price risk management (see at least page 2, lines 16-30).

Dependent claim 81

To independent claim 1, claim 81 adds the limitation that the financial function includes liquidity risk management (see at least page 2, lines 16-30).

Dependent claim 82

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To independent claim 1, claim 82 adds the limitation that the financial function includes operational risk management (see at least page 4, lines 12-16).

Dependent claim 83

To independent claim 1, claim 83 adds the limitation that the financial function includes management of insurable risks (see at least page 5, lines 14-28).

Dependent claim 84

To independent claim 1, claim 84 adds the limitation that the financial function includes electricity price risk management (see at least page 5, lines 14-28).

Dependent claim 85

To independent claim 1, claim 85 adds the limitation that the financial function includes pension fund management (see at least page 5, lines 14-28).

Dependent claim 86

To independent claim 1, claim 86 adds the limitation that the financial function includes real estate management (see at least page 5, lines 14-28).

Dependent claim 87

To independent claim 1, claim 87 adds the limitation that the financial function includes hedging (see at least page 3, lines 1-8).

Dependent claim 88

To independent claim 1, claim 88 adds the limitation that the financial function includes dynamic hedging (see at least page 3, lines 1-8; and page 14, lines 6-13).

Dependent claim 89

To independent claim 1, claim 89 adds the limitation that the financial function includes mortgage pre-payment risk management (see at least page 34, lines 23-27).

Dependent claim 90

To independent claim 1, claim 90 adds the limitation that the financial function includes front-office activities (see at least page 3, lines 1-8).

Dependent claim 91

To independent claim 1, claim 91 adds the limitation that the financial function includes middle-office activities (see at least page 3, lines 1-3).

Dependent claim 92

To independent claim 1, claim 92 adds the limitation that the financial function includes back-office activities (see at least page 3, lines 1-3).

Dependent claim 93

To independent claim 1, claim 93 adds the limitation that the financial function includes front-office and middle-office activities (see at least page 3, lines 1-3).

Dependent claim 94

To independent claim 1, claim 94 adds the limitation that the financial function includes middle-office and back-office activities (see at least page 3, lines 1-3).

Dependent claim 95

To independent claim 1, claim 95 adds the limitation that the financial function includes front-office, middle-office and back-office activities (see at least page 3, lines 1-3).

Independent claim 112

Claim 112 recites a computer-readable medium (see at least FIG. 3, element 3300; page 28, lines 21-26) storing instructions (see at least FIG. 3, element 3400; page 28, lines 21-23) that, when executed by one or more processors (see at least FIG 3, element 3200; page 28, lines 21-23), cause the one or more processors to perform activities (see at least page 28, lines 21-23). Those activities comprise:

relating to a financial function (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) of each of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13):

demonstrating that more than one activity of the agent is transparent to the client; (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28);

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

creating risk management information relating to the financial information (see at least FIG. 1, element 1040; page 19, line 29);

analyzing the risk management information in the context of the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5);

determining an action based on the analysis (see at least FIG. 1, element 1060; page 22, lines 27-28);

facilitating implementation of the action on behalf of the client (see at least FIG. 1, element 1070; page 23, lines 19-20); and

communicating through a network (see at least FIG. 2, element 2900) with the

client (see at least FIG. 2, element 2100) one or more activities of the agent (see at least FIG. 1, elements 1025, 1045, 1055, 1065, and 1075; page 25, lines 5-6).

Independent claim 113

Claim 113 recites an apparatus (see at least FIG. 2, element 2500; FIG. 3, elements 300) for providing financial functions by an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) for each of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13). The apparatus comprises:

relating to a financial function of each client (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3):

means for demonstrating that more than one activity of the agent is transparent to the client (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28; FIG. 2, element 2500; FIG. 3, element 300; page 25, line 27 to page 29, line 10);

means for receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; FIG. 3, element 300; page 18, lines 3-10; page 25, line 27 to page 29, line 10);

means for creating risk management information relating to the financial information (see at least FIG. 1, element 1040; FIG. 2, element 2500; FIG. 3, element 300; page 19, line 29; page 25, line 27 to page 29, line 10);

means for analyzing the risk management information in the context of the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5; page 25, line 27 to page 29, line 10);

means for determining an action based on the analysis (see at least FIG. 1, element 1060; FIG. 2, element 2500; FIG. 3, element 300; page 22, lines 27-28; page 25, line 27 to page 29, line 10);

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means for facilitating implementation of the action on behalf of the client (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19- 20; page 25, line 27 to page 29, line 10); and

means for communicating to the client through a network one or more activities of the agent (see at least FIG. 1, elements 1025, 1045, 1055, 1065, and 1075; FIG. 2, elements 2100, 2500, 2900; FIG. 3, element 300; page 25, lines 1-25; page 25, line 27 to page 29, line 10).

Independent Claim 114

Claim 114 recites a computer-assisted method (see at least page 25, lines 1-4; FIGs. 1, 2, 3) for a client to outsource financial functions to an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) representing a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising the activities of:

providing financial information on one or more financial functions of each client (see at least page 1, lines 5-7) to a computer of the agent (see at least FIG. 1, elements 1020, 1025; FIG. 2, elements 2100, 2900, 2500; page 18, lines 3-10; page 25, lines 1-25);

enabling the agent to determine an action based on an analysis of risk management information created from the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5); and

allowing the agent to facilitate the implementation of the action (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-20).

Dependent claim 123

To independent claim 114, claim 123 adds the activity of silently monitoring across a network one or more of the agent's activities (see at least page 11, lines 14-20).

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Dependent claim 124

To independent claim 114, claim 124 adds the activity of requesting notification of an effect of one or more actions of the agent on the risk management analysis (see at least page 7, lines 16-18; page 11, lines 14-20; and page 24, lines 26-29).

Dependent claim 126

To independent claim 114, claim 126 adds the activity of requesting information on one or more reasons behind an action determined by the agent (see at least page 24, lines 17-19).

Independent claim 136

Claim 136 recites a computer-readable medium (see at least FIG. 3, element 3300; page 28, lines 21-26) storing instructions (see at least FIG. 3, element 3400; page 28, lines 21-23) that, when executed by one or more processors (see at least FIG 3, element 3200; page 28, lines 21-23), cause the one or more processors to perform activities (see at least page 28, lines 21-23). Those activities comprise:

providing financial information on one or more financial functions (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) of an institutional or corporate client (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13) to an agent (see at least FIG. 1, elements 1020, 1025; FIG. 2, elements 2100, 2900, 2500; page 18, lines 3-10; page 25, lines 1-25);

enabling the agent to determine an action based on an analysis of risk management information created from the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5); and

allowing the agent to facilitate the implementation of the action (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-20).

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Independent claim 137

Claim 137 recites an apparatus (see at least FIG. 2, element 2500; FIG. 3, elements 300) for a client to outsource financial functions to an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) representing a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising:

means for providing financial information on one or more financial functions of each client (see at least page 1, lines 5-7) to a computer of the agent (see at least FIG. 1, elements 1020, 1025; FIG. 2, elements 2100, 2900, 2500; page 18, lines 3-10; page 25, lines 1-25; page 25, lines 1-25; page 25, line 27 to page 29, line 10);

means for enabling the agent to determine an action based on an analysis of risk management information created from the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5; page 25, lines 1-25; page 25, line 27 to page 29, line 10); and

means for allowing the agent to facilitate the implementation of the action (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-20; page 25, lines 1-25; page 25, line 27 to page 29, line 10).

Independent claim 138

Claim 138 recites a computer-assisted method (see at least page 25, lines 1-4; FIGs. 1, 2, 3) for an agent to provide financial functions (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) to each (see at least page 16, line 28 through page 17, line 3) of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising the activities of:

regarding a financial function of a client from the plurality of clients (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3):

demonstrating to the client the potential transparency of activities of the

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agent (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28);

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

analyzing risk management information created from, and in the context of, the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5); and

facilitating implementation, on behalf of the client, of an agent's action based on the analysis (see at least FIG. 1, element 1070; page 23, lines 19-20).

Independent claim 139

Claim 139 recites a computer-assisted method (see at least page 25, lines 1-4; FIGs. 1, 2, 3) for an agent to provide financial functions to each (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising the activities of:

regarding a financial function of each client from the plurality of clients (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3):

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

analyzing risk management information created from, and in the context of, the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5);

facilitating implementation of a decision of the agent that is based on the analysis (see at least FIG. 1, element 1070; page 23, lines 19-20); and

enabling the client to monitor through a network activities of the agent (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-

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28).

VL   GROUNDS OF REJECTION

Each of claims 1-113 and 138 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

Each of claims 114-135, 137, and 139 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Each of claims 114-126, 129, 135, 137, and 139 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, Underwood (U.S. Patent No. 5,873,066) was cited.

VII.   ARGUMENT

A. Generally

Because the legal standards for claim construction have very recently changed, it is not surprising that all of the claim rejections are contrary to those legal standards, and thus improper.

On 12 July 2005, the *en banc* Federal Circuit, in *Phillips v. AWH Corp.*, No. 03-1269 (Fed. Cir. 2005), clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction **in light of the specification as it would be interpreted by one of ordinary skill in the art**";

2. the words of a claim "are generally given their ordinary and customary meaning";

3. the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application";

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4. "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent,** including the specification";

5. even "the context in which a term is used in the asserted claim can be highly instructive";

6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor's lexicography governs**";

7. even "when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents";

8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office"; and

9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent."

Applicant respectfully submits that this correct legal standard for claim construction negates and/or contradicts each of the claim rejections, as well as the "Note" appearing on page 4 of the Office Action.

B. The Written Description Rejections

Each of claims 1-113 and 138 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. These rejections are respectfully traversed.

According to MPEP 2163.04, the "description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to

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rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)." In the present Office Action, neither evidence nor reasoning has been presented to rebut the presumption. Further, MPEP 2163.04 instructs that "examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims" (*citing In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)). Also, MPEP 2163.04 instructs that "[i]n rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion." No such findings of facts have been set forth.

Applicant respectfully submits that despite the failure of the Office Action to present a *prima facie* rejection under 35 U.S.C. 112, first paragraph, one of ordinary skill in the art would find that the application contains at least adequate descriptive support for the phrase "demonstrating that more than one activity of the agent is transparent to the client", which appears in claims 1-113, and the phrase "demonstrating to the client the potential transparency of activities of the agent ", which appears in claim 138.

As explained in the application on page 7, lines 10-19:

> *Transparency can mean enabling the communication of information and/or the access to information across a network. Real-time transparency means that the information would reach the other party with a delay of less than say a relatively few seconds (such as, for example, within 0 to 60 seconds, 0 to 15 seconds, and/or 0 to 5 seconds). Near-real-time transparency means that the information would reach the other party with a delay longer than just a relatively few seconds (such as, for example, within 5 to 600 seconds, 10 to 60 seconds, and/or 15 to 30 seconds). On-demand transparency means that the information reaches a requesting party only after requested. Thus, on-demand information can be received in real-time, near-real-time, or after a substantial delay.*

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At page 9, lines 18-22 is found:

In the few instances where fund managers provide investment management
functions to their clients as agents, rather than as principals selling fund shares
*and trading on behalf of the fund, they have done so **without demonstrating***
transparency to their clients and without enabling the clients to interact with the
agent, access information, and/or monitor the agent's activities.

Page 11, lines 4-20 describe "transparency":

Notably, in many situations, real-time or near-real-time transparency can be
necessary for an agent to earn sufficient trust from a client so that the client is
willing to outsource entire financial functions, and in some situations can also be
necessary for the agent to be willing to assume the liability associated with taking
*over such financial functions. **To achieve such transparency**, certain embodiments*
*of the invention recognize that **a network-based user interface** can be*
*advantageously provided to **enable a client to access continuously**, in real-time or*
*near-real-time, **information relating to the day-to-day and/or intra-day activities***
of an agent acting on behalf of the client**. In certain situations, **this monitoring
*can be done more effectively than **monitoring the activities** of the client's own risk*
*management and trading staff **through a glass partition**. The client might access,*
*through the network-based user interface, the risk management **information***
***generated by the agent** and thus determine how the agent reacts to such*
information without the need to request the information from the agent. The access
*to the information on the activities of the agent can be silent, wherein **the agent is***
***not made aware when the client is monitoring the agent's activities**, or can be*
based upon requests made by the client through the network.

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At page 12, lines 24-29 is found:

> *The above type of transparent access to information between a client and an agent,*
> *combined with communication security over public networks, the widespread use*
> *of data interchange standards, and the proliferation of exchanges and*
> *counterparties that permit and/or facilitate the electronic identification, negotiation,*
> *and execution of trades, have helped to make certain embodiments of the present*
> *invention useful, practical and commercially feasible today.*

Page 17, line 27 through page 18, line 2 explains that:

> *Method 100 can begin at activity 1010 by **demonstrating** that one, two, or more of*
> *the agent's activities can be **transparent** to the client. The demonstration can be*
> *performed by the agent, and can include an **explanation of the activities of the***
> ***agent. The demonstration can also explain how the client might be enabled by***
> ***the agent to access information and/or monitor activities of the agent.***

Page 24, lines 13-22 states that:

> *Activity 1080 can **enable the client to examine a verifiable audit trail of***
> *communication given to and received from the client by the agent, as well as a*
> ***record of the information and data created and/or used by the agent to conduct***
> ***analyses and/or undertake actions on behalf of the client.** Such records might be*
> *used with the benefit of hindsight to reconstruct the reasons for the actions*
> *undertaken by the agent on behalf of the client. **This historical transparency can***
> *protect both the client and the agent from any disputes that might arise and give the*
> *client and its regulator confidence that the agent is performing its functions with*
> *competence and is working in the best interests of the client.*

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Page 29, lines 20-23 describes that:

> *In this example, the agent first demonstrates the transparency of the method. The demonstration might involve a presentation to the client on how he might be enabled to access information and/or a trial period of one, two, or more of the agent's activities described below.*

Page 31, lines 4-10 explain that:

> *The agent might provide the client with the ability to remotely access and/or monitor, on the client's computer screen, in real-time and/or near-real-time, the risk management information being generated and how the agent is reacting to that risk management information. The analysis of risk management information and/or instructions/ recommendations to the client can be provided by the agent over a network, such as via a Web site, on any desired basis, such as hourly, daily, and/or weekly.*

Page 32, lines 6-8 recite:

> *The agent can implement actions on behalf of the client unless the client via the network halts the actions and/or removes the agent's authority to take actions on his behalf.*

As evidenced by the Information Disclosure Statement by Applicant filed on 22 July 2005, there are numerous prior art references that demonstrate exemplary technologies for "remotely monitoring" "via a network" on a "computer screen, in real-time and/or near-real-time", "information being generated and how the" operator of the remote computer "is reacting to that" "information", and that these exemplary technologies were well-known by those of

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ordinary skill in the art as of the filing date of the present application.

For example, the submitted U.S. Patent No. 5,241,625 (Epard), which was filed in 1990, allegedly describes a software program called "**Timbuktu**" (*see* col. 13, lines 51-53) as a "system for **remotely observing and optionally controlling information**, including text and graphical images, **displayed on a computer** from among both homogeneous and heterogeneous computers coupled **in a network**" (*see* Abstract).

Submitted U.S. Patent No. 5,506,573 (Ewing) allegedly recites that "[s]oftware such as **Timbuktu** Remote or **Carbon Copy** Mac can **allow the computer to be operated from a remote location as if the operator were actually in front of the computer**, and not one connected to it." *See* col. 1, lines 63-67.

Submitted U.S. Patent No. 5,684,952 (Stein) allegedly recites a "**system for enabling an administrator to monitor and control individual workstations within the network.**" *See* col. 1, lines 12-14. Stein also states that a "screen sharing component 49 processes data pertaining to the information being displayed on the student's screen, and furnishes this data to the master workstation 10. One example of a suitable screen sharing application is the **Timbuktu** product developed by Farallon Computing, Inc. of Alameda, Calif. " *See* col. 5, lines 60-65.

Submitted U.S. Patent No. 5,732,212 (Perholtz) allegedly recites a "system and method for **accessing, controlling and monitoring a data processing device**". *See* Abstract. Perholtz further states that "[n]etwork software utility **programs exist that permit one workstation to access and control the activities of another workstation connected to the network.** Products that tall into this category include, **Carbon Copy for LANs**, developed by Microcom Inc.". *See* col. 3, lines 12-17.

Submitted U.S. Patent No. 6,173,332 (Hickman), which claims priority to a 1996 filing, allegedly recites a "[m]ethod and apparatus for computing over a wide area network". *See* Title. Hickman further states that "[t]here currently exists a species of **software which permits a first computer ("master computer") to monitor and/or control the functionality of a second**

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computer (slave computer). For example, the programs **"Timbuktu" and "Carbon Copy"** permit a master computer to control a slave computer, or to simply monitor the activity of the slave computer. The owner of the "Timbuktu" software, Farallon Computing, Inc. of Alameda, Calif. has obtained a U.S. Pat. No. 5,241,625 entitled "Screen Image Sharing Among Heterogeneous Computers", the disclosure of which is incorporated herein by reference. More specifically, these prior art software products provide a methodology which **allows the screen of a master computer to display an image of the screen of a slave computer. Optionally, the keyboard and mouse of the master computer can provide inputs to (and thereby control) the slave computer as well. "** *See* col. 3, lines 11-26. Hickman asserts that a "**client computer** (which may or may not be one of the computers on the Internet) can **interact with a host computer via the Internet** in varieties of ways. For example, the client computer can be used **to simply monitor the screen of the host computer**. Alternatively, the client computer can be used to both monitor the screen of the host computer **and to provide inputs to the host computer** via a keyboard, mouse, or other input device." *See* col. 4, lines 23-30. A "multi-tasking operating system on a host computer (such as Windows NT.TM. from Microsoft Corporation) would allow each window to be a 'virtual machine' for one or more client computers". *See* col. 4, lines 45-48. Thus "users from multiple client computers can access a single host machine to permit... multiple individual efforts on that computer system". *See* col. 5, lines 63-65.

Considering the entirety of the present application, which includes its prosecution history and cited references, one of ordinary skill in the art would find that the present application provides at least adequate descriptive support for "transparent" and "transparency". Further, one of ordinary skill in the art would find adequate descriptive support in the present application for the claimed phrases "demonstrating that more than one activity of the agent is transparent to the client" and "demonstrating to the client the potential transparency of activities of the agent ". Consequently, reversal of these rejections is respectfully requested.

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C. The Indefiniteness Rejections

Each of claims 114-135, 137, and 139 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. These rejections are respectfully traversed.

Regarding indefiniteness rejections, the Federal Circuit has held that the law is clear that **if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention,** the claims are definite under Section 112, second paragraph. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, (Fed. Cir. 1985), *cert. dismissed*, 474 U.S. 976 (1985).

Upon a careful reading of the specification, one of ordinary skill in the art would conclude that the claim term "client" only refers to a "corporate or institutional client", and that all such described and claimed "clients" are served by the "agent". One of skill in the art would also find it clear from the context of the specification that the applicant only refers to "corporate or institutional clients" and not to "retail clients" (i.e., individuals). Retail clients do not have the complex financial functions (e.g. treasury management, credit management, asset and liability management, risk management, trading, etc.) the outsourcing of which is the subject of the application. Furthermore, the term "corporate and institutional clients" clearly excludes retail clients or individuals as it refers to corporations, insurance companies or banks, which, for the purposes of this application, are the only end-user clients or real customers. Accordingly, whenever the term "client" is used, one of ordinary skill in the art would interpret it to mean "corporate or institutional clients" as these are the only real customers of the "agent" who provides the outsourced services described in the present application.

Further, of record in the prosecution of the present application is a 37 CFR § 1.132 Declaration of Dr. William W. Sihler, a professor of Business Administration and Finance at University of Virginia, and one skilled in the art of financial management and financial services. No evidence has been properly presented to contradict any aspect of Dr. Sihler's Declaration.

In particular, paragraph 18 of Dr. Sihler's uncontroverted Declaration establishes that "one skilled in the art would interpret the words 'institutional or corporate' as used in [the present application] to be required limitations of each of claims 1-139, and to define the type of 'client' cited in those claims".

Thus, no *prima facie* argument has been presented that claims 114-135, 137, and 139 are indefinite, and even if presented, such argument fails on reasonable scrutiny and proper application of the law. Consequently, reversal of the rejections of claims 114-135, 137, and 139 is respectfully requested.

D. The Anticipation Rejections

1. Claims 114-126, 129, 135, 137, and 139

Each of claims 114-126, 129, 135, 137, and 139 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, Underwood (U.S. Patent No. 5,873,066) was cited. These rejections are respectfully traversed.

Underwood fails to establish a *prima facie* case of anticipation. *See* MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst*

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Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.") The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

Each of claims 114-126, 129, 135, and 137 recites a "method" or "apparatus" "for a client to **outsource financial functions** to an **agent** representing a plurality of institutional or corporate clients". Claim 139 recites a "computer-assisted method for an **agent** to provide **financial functions** to each of a plurality of institutional or corporate clients".

As explicitly defined at line 12 on page 10 of the present application, an **"agent" is a "financial risk manager"**.

Of record in the prosecution of the present application is a 37 CFR § 1.132 Declaration of Dr. William W. Sihler, a professor of Business Administration and Finance at University of Virginia, and one skilled in the art of financial management and financial services. No evidence has been properly presented to contradict any aspect of Dr. Sihler's Declaration.

Specifically, paragraph 12 of the uncontroverted Declaration of Dr. Sihler establish that "one skilled in the art would instantly recognize the term 'financial risk manager', as one at whom are directed books such as *Managing Financial Risk: A Guide to Derivative Products, Financial Engineering, and Value Maximization*, by Charles W. Smithson, Publisher: McGraw-Hill Trade; 3rd edition (June 30, 1998), ISBN: 007059354X (see back cover 'for years, financial executives and risk managers have recognized Charles Smithson's *Managing Financial Risk* as the authoritative source for comprehensive coverage of risk management products')".

The meaning for the phrases "to outsource" and "financial functions" are impliedly defined in the specification of the present application. Under the current legal standards, described *supra*, those definitions must control examination of those claims that recite these phrases.

"Typical financial functions are treasury, credit management, risk management, and

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trading, together with several of their associated sub-functions." *See* page 2, lines 16-17. "The activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments." *See* page 3, lines 1-3. A detailed listing of the activities of typical front-offices, middle-offices, and back-offices begins on page 3, at line 5, and spans to page 5, at line 12.

Notably, the "activities of the financial functions operate upon financial instruments." *See* page 5, line 14. These "financial instruments" "can include each individual transaction/agreement that has been executed and/or might be executed, as well as exposures and/or operational cashflows". *See* page 5, lines 15-16. But "[n]ot all activities upon financial instruments define a financial function." *See* page 6, line 7. "For example, a portfolio of derivatives with the same counterparty does not necessarily constitute a financial function just because all the financial instruments (i.e. all the derivatives) have a common counterparty. However, if the counterparty is the only counterparty with whom the client trades derivatives in connection with, say, its ALM function, and the portfolio of derivatives is accompanied by a set of guidelines that describe, for example, its purpose, objectives, and/or criteria for measuring performance, then such activities upon the portfolio of derivatives might qualify as a financial function." *See* page 6, lines 7-10.

Underwood does not teach or suggest, expressly or inherently, an "agent", a "method" or "apparatus" "for a client to outsource financial functions to an agent representing a plurality of institutional or corporate clients", or a "computer-assisted method for an agent to provide financial functions to each of a plurality of institutional or corporate clients".

Instead, Underwood is allegedly directed to a "computer-implemented system for managing the underwriting, quoting and binding by an insurance company of an excess casualty insurance policy for an insured having a primary insurance policy with a primary insurance limit amount". *See* Abstract. "The system develops the quotation using a detailed description of the

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insured's operation, the minimum premium amount information, the selected hazard code, the selected risk modifier code, primary insurance limits, and one or more attachment points." *Id.*

Underwood explains that "[i]nsurance companies that write excess insurance often receive submissions through **licensed insurance wholesalers, brokers and retail producers**. When such an insurance business producer wishes to compete for an excess policy, it is important for the insurance company to be able to **provide the business producer with a quote** which accurately reflects the characteristics of the risk, and, if necessary, to audit any information provided by the business producer before any quote is issued." *See* col. 1, lines 50-59.

Thus, considering the entire specification and prosecution history of the present application, one of ordinary skill in the art would find it quite clear that a "financial function" has more structure and involves more complex activities than simply requesting quotes for insurance policies and executing agreements on those insurance policies.

Moreover, Underwood makes no mention of any type of "agent", and particularly not an "agent" of the particular type defined in the present application. Further, Underwood provides no teaching or suggestion, either explicitly or inherently, that Underwood's "licensed insurance wholesalers, brokers and retail producers" are equivalent to an "agent" or a "financial risk manager" as those terms are defined in the present application.

Accordingly, it is respectfully submitted that the rejections of claims 114-126, 129, 135, 137, and 139 are unsupported by Underwood and should be reversed.

2. Claim 123

Claim 123 recites, yet Underwood does not teach or suggest, expressly or inherently, "**silently monitoring** across a network one or more of the **agent's** activities". Instead, Underwood merely "require[s]" "the user" "to document reasons for writing excess coverage", and "[t]his documentation preferably takes place on-line and is directly entered into the system by the insurance underwriter", rather than the "licensed insurance wholesalers, brokers and retail

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producers". Accordingly, it is respectfully submitted that the rejection of claim 123 is unsupported by Underwood and should be reversed.

3. Claim 124

Claim 124 recites, yet Underwood does not teach or suggest, expressly or inherently, "requesting **notification of an effect** of one or more **actions of the agent on the risk management analysis**". Instead, Underwood merely "require[s]" "the user" "to document reasons for writing excess coverage", and "[t]his documentation preferably takes place on-line and is directly entered into the system by the insurance underwriter", rather than the "licensed insurance wholesalers, brokers and retail producers". Accordingly, it is respectfully submitted that the rejection of claim 124 is unsupported by Underwood and should be reversed.

4. Claim 126

Claim 126 recites, yet Underwood does not teach or suggest, expressly or inherently, "requesting information on one or more reasons behind **an action determined by the agent**". Instead, Underwood merely "require[s]" "the user" "to document reasons for writing excess coverage", and "[t]his documentation preferably takes place on-line and is directly entered into the system by the insurance underwriter", rather than the "licensed insurance wholesalers, brokers and retail producers". Accordingly, it is respectfully submitted that the rejection of claim 126 is unsupported by Underwood and should be reversed.

VIII. CLAIMS APPENDIX

The previously submitted Appendix A sets forth all pending claims in the state in which they were appealed.

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IX.   **EVIDENCE APPENDIX**

A copy of the Declaration Under 37 C.F.R. § 1.132 of William W. Sihler was previously submitted as Appendix B.

X.   **RELATED PROCEEDINGS APPENDIX**

There continue to be no related proceedings.

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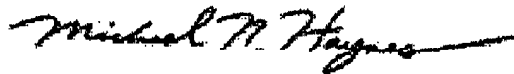
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SUMMARY

In view of the above, Applicant submits that all claims on appeal are patentable over the cited art and respectfully requests that the Board of Patent Appeals and Interferences reverse the rejections of claims 1-139 and direct that the application be passed to issue.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

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Respectfully submitted,

Michael Haynes PLC

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